

Remarks:

Reconsideration of the application is requested.

Claims 1-5 and 11-24 remain in the application. Claims 1 and 3 have been amended. Claims 11-12 and 18 have been withdrawn from consideration.

In item 3 on page 2 of the above-identified Office action, claims 1-5, 13-17, and 19-24 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

The Examiner's comments have been considered, and claims 1 and 3 have been amended to recite "obtaining a desired level of comparatively good mechanical decoupling from a printed circuit board".

MPEP §2173.05 (8<sup>th</sup> ed, 2001) states:

**2173.05(b) Relative Terminology**

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

...

**REFERENCE TO AN OBJECT THAT IS VARIABLE  
MAY RENDER A CLAIM INDEFINITE**

A claim may be rendered indefinite by reference to

an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). On the other hand, a claim limitation specifying that a certain part of a pediatric wheelchair be "so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats" was held to be definite. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). The court stated that the phrase "so dimensioned" is as accurate as the subject matter permits, noting that the patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

According to MPEP §2173.05, a relative term does not automatically renders a claim indefinite. It is believed that the key language in §2173.05 regarding relative terminology is that "[a]cceptability of the claim language depends on whether one of ordinary skill in the art would **understand what is claimed**, in light of the specification."

It is believed that a person skilled in the art would know what is meant and claimed by "obtaining a desired level of comparatively good mechanical decoupling from a printed circuit board".

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. The above-

noted changes to claim 1 and 3 are provided solely for the purpose of satisfying formal requirements, clarification, or are made solely for cosmetic reasons to clarify the claims. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

In item 5 on page 3 of the Office action, claims 1-5 and 13-17, and 19-25 have been rejected as being obvious over *Akagawa et al.* (EP 0 734 059) in view of *Farnworth et al.* (US 6,639,600), *Akram et al.* (US 6,107,109), and *IBM Technical Bulletin*, "Solder Plated Resin Ball", Vol. 38, pages 463-464 (May 1995) under 35 U.S.C. § 103.

Enclosed herewith is a copy of a *Declaration under 37 CFR 1.131* declaring that the invention of the above-identified application was "reduced to practice" prior to July 6, 1998, predating the prior art date of *Farnworth et al.*. It is therefore believed that *Farnworth et al.* is not available as prior art against the invention of the instant application and, consequently, the prior art rejection applying *Farnworth et al.* is believed to be moot.


Enclosed as corroborating evidence is the *Invention Declaration/Disclosure (Erfindungsmeldung)* dated January 26, 1998, together with an English translation of the relevant

passages, evidencing that the invention of the instant application was "reduced to practice" prior to July 6, 1998.

In view of the foregoing, reconsideration and allowance of claims 1-5 and 11-24 are solicited.

Please charge any fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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